

**REMARKS**

**I. Introduction**

Claims 1, 3, 6, 17 and 22-25 are pending in this application.

Claim 22 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1, 3, 6, 17 and 22-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 6,141,488 (hereinafter "Knudson") in view of US Patent No. 6,208,799 (hereinafter "Marsh") in further view of US Patent Application No. 2002/0081096 (hereinafter "Watanabe") and in further view of US Patent No. 6,564,005 (hereinafter "Berstis").

The rejections of the pending claims are respectfully traversed.

**II. Applicants' Response to the Rejection under 35 U.S.C. § 112**

Claim 22 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner's rejection is respectfully traversed.

More specifically, the Examiner contends that claim 22 contains subject matter which was not described in the specification in such a way so as to enable one skilled in the art to make or use the claimed invention. In making this rejection, the Examiner specifically points to the step of determining the number of tuners that are available and states that it is merely assumed that many systems have multiple tuners.

Contrary to the Examiner's contention, however, the specification explicitly discloses systems that have multiple tuners. For example, paragraph 0040 of the specification recites that, "[i]n one embodiment of the present invention, the PVR uses multiple tuners." In addition, "[f]igure 2 shows various configurations for one of the multiple tuners associated with the PVR." Hence, the specification does more than simply assume that many systems have multiple tuners, and explicitly discloses such systems, thereby enabling one skilled in the art to make or use the claimed invention.

Therefore, applicants respectfully request that the rejection of claim 22 under 35 U.S.C. § 112, first paragraph, be withdrawn.

III. Applicants' Response to the Rejection under 35 U.S.C. § 103(a)

Claims 1, 3, 6, 17 and 22-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson in view of Marsh in further view of Watanabe and in further view of Berstis. Applicants respectfully traverse this rejection for the reasons set forth below.

A. Claims 1 and 22:

Applicants' independent claim 1 is directed to a method for transferring a broadcast signal to a storage device. Instructions to transfer to a storage device two or more time slots on one or more channels are received. If the instructions cause a conflict, the conflict is resolved. More specifically, a first one of the time slots, which includes a user extended lead or trail time slot, is given a first priority, while a second one of the time slots, which includes a core time slot that is treated as a separate entity from the extended time slot, is given a second priority. If the user does not choose a solution to the conflict, the conflict is resolved automatically, by selecting the first priority or the second priority as the higher priority, depending on whether the first time slot is a trail or lead time slot. Accordingly, in the absence of a user input, applicants' claimed method for resolving a potential conflict is based on a technique in which time slots are associated with varying priorities depending on whether these time slots include core time slots or extended time slots.

The Examiner states that Knudson fails to disclose core and extended time slots that have various priorities and tries to make up for this deficiency by relying on Marsh (see pages 4 and 5 of Office Action).

Although Marsh suggests priority schemes for resolving conflicts in VCR-record-timers, nowhere does it distinguish core time slots from extended time slots, when it comes to prioritizing time slots to be recorded. The example relied on by the Examiner uses a priority scheme for "clearing the conflicting VCR-record-timer whose record time that is the

most distant from the current time" (column 10, lines 30-35). Like any other example disclosed in Marsh (e.g., column 9, lines 61-67), this example merely refers to clearing a record timer when a time slot conflict arises and does not distinguish between different priorities associated with core time slots relative to extended ones. Accordingly, Marsh does not teach or suggest an extended lead or trail time slot having a first priority and a core time slot having a second priority, as recited in applicants' claim 1. Not only does Marsh not show such a feature, but neither do Watanabe nor Berstis.

For the foregoing reasons, applicants submit that, even if Knudson, Marsh, Watanabe and Berstis were combinable (which applicants reserve the right to dispute), the alleged combination fails to teach or suggest all of the features of claim 1. Accordingly, the Examiner has failed to make a *prima facie* case of obviousness with respect to claim 1.

For the reasons set forth above, independent claim 1 is allowable over the cited references. Claim 22 depends from allowable claim 1 and is therefore allowable for at least the same reasons. Therefore, applicants respectfully request that the §103 rejection of claims 1 and 22 be withdrawn.

**B. Claims 3, 17 and 23:**

Applicants' independent claims 3 and 17 are also directed to a method and system for transferring a broadcast signal to a storage device and resolving conflicts potentially caused by instructions to effect such transfers. In this instance, a first time slot, which includes an automatically extended lead or trail time slot (as opposed to the user extended time slot specified in claim 1), has a first priority while a second time slot, which includes a core time slot, has a second priority. The conflict is resolved automatically by selecting the second priority as the higher priority, if the user does not choose a solution to the conflict. Accordingly, much like in claim 1, conflict resolution according to each of claims 3 and 17 is based on a technique in which time slots are associated with varying priorities depending on whether these time slots include core time slots or extended time slots.

The Examiner once again relies on the combination of Knudson, Marsh, Watanabe and Berstis to show the features described above (see pages 3-5 of Office Action).

However, applicants have demonstrated in the preceding section that none of these references teach or suggest an extended lead or trail time slot having a first priority and a core time slot having a second priority. Accordingly, claims 3 and 17 are also allowable at least for the same reasons that claim 1 is allowable. Claim 23 depends from allowable claim 17, and is therefore allowable for at least the same reasons. Therefore, applicants respectfully request that the §103 rejection of claims 3, 17 and 23 be withdrawn.

C. Claim 6:

Applicants' independent claim 6 is again directed to a method for transferring a broadcast signal to a storage device and resolving conflicts. According to this claim, a plurality of solutions for resolving a conflict, as well as a corresponding cumulative priority for each solution, are determined. A cumulative priority is determined from a user extended lead time slot that is given a first priority, a user extended trail time slot that is given a second priority, an automatically extended lead or trail time slot that is given a third priority, and a core time slot that is given a fourth priority. The conflict is resolved by choosing a solution out of one or two lowest priority solutions if the user does not choose a solution from the ones the user is presented with.

The Examiner contends that Knudson discloses "establishing cumulative priority for each of said solutions" and "determining and choosing one or two lowest priority solutions " (see page 6 of Office Action).

The portions referenced by the Examiner in Knudson (Figure 7a, Elements 102, 104, 106 and 108) show a method of determining whether a program selected for recording has been locked, recording the program if it is not locked and requesting and comparing a parental control PIN if it is locked. It is very unclear how recording a program that is locked through a parental control mechanism can in any way be likened to choosing low priority solutions to a conflict based on established cumulative priorities for various solutions. Contrary to the

Examiner's contention, applicants submit that Knudson does not show establishing a cumulative priority for solutions as recited in claim 6. First, the particular method outlined in Figure 7a of Knudson does not determine and present a user with solutions to a conflict as claimed by applicants because there is no conflict between time slots identified in Knudson. Second, there is no mention whatsoever of any cumulative priority in Knudson. Figure 7a Elements 106 and 108 show the options available when a selected program is locked and when it is not locked. Presenting such different options when a program is locked and when it is not locked cannot be compared with presenting solutions to a conflict based on a cumulative priority. Not only does Knudson not show the above features recited in claim 6, but neither do Marsh, Watanabe nor Berstis.

For the foregoing reasons, applicants submit that, even if Knudson, Marsh, Watanabe and Berstis were combinable (which applicants reserve the right to dispute), the alleged combination fails to teach or suggest all of the features of claim 6. Accordingly, the Examiner has failed to make a *prima facie* case of obviousness with respect to claim 6.

For the reasons set forth above, claim 6 is allowable over the cited references. Therefore, applicants respectfully request that the §103 rejection of claim 6 be withdrawn.

**D. Claims 24 and 25:**

Claims 24 and 25 are yet again directed to a method and system for transferring a broadcast signal to a storage device and resolving conflicts. According to these claims, a system queue is provided for receiving time slots that cause a conflict, and the conflict is resolved by comparing the time slots in the system queue.

The Examiner states that Knudson, Marsh and Watanabe fail to disclose, among other things, providing a system queue. The Examiner tries to make up for this deficiency by relying on Berstis. Specifically, the Examiner contends that Berstis teaches "a queue of available programs for recording" (see page 7 of Office Action).

Berstis, however, describes allowing a user to create a user profile that contains user information, and a program schedule that contains a list of programs to be recorded

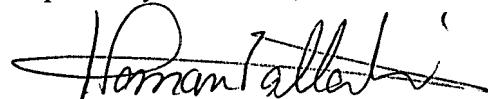
(Figure 10). The program schedule may include information about a program to be recorded such as the channel, days of the week, and hours to record (column 8 lines 57-65). Although Berstis discloses allowing a user to create a list of programs scheduled to be recorded, Berstis does not show or suggest providing a system queue to receive time slots that cause a conflict in recording. This is because the program schedule in Berstis contains all the programs the user is interested in recording while applicants' claimed system queue includes specific time slots that cause a conflict in recording.

For the foregoing reasons, applicants submit that, even if Knudson, Marsh, Watanabe and Berstis were combinable (which applicants reserve the right to dispute), the alleged combination fails to teach or suggest all of the elements of claims 24 and 25. Accordingly, the Examiner has failed to make a prima facie case of obviousness of claims 24 and 25. Therefore, applicants respectfully request that the §103 rejection of claims 24 and 25 be withdrawn.

#### IV. Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Reconsideration in light of the foregoing remarks and a favorable action are respectfully requested.

Respectfully submitted,



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